

Serial No. 10/754,923  
Response to Office Action of November 26, 2004

Remarks

Applicants have amended the claims with respect to the set of claims filed with their Supplemental Preliminary Amendment on April 30, 2004. The Examiner is kindly requested to check that the amendments made in the description and claims in this Supplemental Preliminary Amendment have been entered. (It appears that the Examiner may have examined the set of claims in the Annex to the Supplemental Preliminary Amendment. The Annex provided the claims as they should have been after making the amendments in the Preliminary Amendment if the undersigned's printer had been working properly. Please accept the apologies of the undersigned for the confusion caused by the printer malfunction).

Claim 7 has been amended by replacing the term "X<sup>0</sup>" with "X<sub>o</sub>".

In Claim 8, the definition of R<sub>1</sub> has been amended. The previous definition of R<sub>1</sub>, which allowed for R<sub>1</sub> to be (1-6C)alkyl, was not consistent with current Claim 1. Support for the amendment may be found at page 15, line 14.

Claim 34 has been amended by deleting the words "is carbon and". The dependency of this claim has also been amended.

New Claim 38 is directed to those compounds of Claim 33 that have the conformation as defined in Claim 34. The compounds are useful as intermediates in the preparation of compounds of Claim 34. (See page 32, lines 16 to 30 and page 9, lines 3 to 6 of the specification).

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New Claim 39 is supported by page 21, line 11 of the description.

#### Claim Objections

It is respectfully submitted that Applicants' amendment in Claim 7 has removed the basis for the Examiner's objections. (The missing bond occurred in the Annex to the Supplemental Preliminary Amendment, not the Supplemental Preliminary Amendment itself).

#### Objection

The Examiner has objected to Claims 35-37.

In view of the amendments made in Claims 7 and 34, it is respectfully submitted that Claims 35-37 are now allowable.

#### Claim Rejections - 35 U.S.C. § 112

The Examiner has rejected Claim 34, because it refers back to cancelled Claim 13.

Applicants have amended the dependency of Claim 34 so that the claim no longer refers back to Claim 13.

The Examiner has also objected to the way in which Applicants have sought to define stereochemistry in Claim 34.

Applicants respectfully submitted that the Claim as amended by deletion of the words "is carbon and" is clear.

When the definition in Claim 1 "Y (the  $\alpha$ -atom) is a CH group" is considered, it will be seen that the resulting compound is a glycine amide derivative with a Cy-group on the  $\alpha$ -carbon. See, for example, the structural formulas at page 31 of the description and in Claims 23 and 24. The meaning of Claim 34 is that the configuration at Y, i.e. CH, of the "D-glycine" amide corresponds to that at the "CH" of the D- $\alpha$ -glycine amino acid  $\text{NH}_2\text{-CH}(\text{Cy})\text{-COOH}$ . (The term

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"construction" in the definition is not intended to relate to the method of preparation, but rather to the structural definition, itself.)

#### **Telephone Conversation with the Examiner**

The undersigned telephoned the Examiner on February 18, 2005 and drew his attention to the fact that Claim 1 and certain of the generic claims read on the species disclosed in the parent application. The Examiner responded that he had not noted this, and that it may be necessary for him to raise an obviousness-type double patenting rejection. He suggested that an obviousness-type double patenting rejection could be overcome either by introducing an appropriate disclaimer of the species or by filing a terminal disclaimer.

The undersigned also drew the Examiner's attention to the claim amendments submitted on April 30, 2004 with Applicant's Supplemental Preliminary Amendment. The Examiner checked the file and observed that he had overlooked these claims. He agreed that the amendments filed in the present response could take as their starting point the amendments filed on April 30, 2004.

#### **Terminal Disclaimer**

Applicant has noted with appreciation that the Examiner has not restricted the claims in the present application, unlike in the parent application.

The claims in the parent application were subject to a restriction requirement, but Applicants voluntarily restricted them further to a single species. This species is not claimed specifically in the present application, claim 26 having been amended to exclude it. However, the species does fall within the scope of Claim 1 and several dependent generic claims.

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The issue fee on the parent application has been paid, and the application is awaiting issue.

In view of the Examiner's comments over the telephone and in order to expedite allowance of this application, Eli Lilly and Company, the assignee of the entire, right title and interest in this application, is filing a terminal disclaimer. The terminal disclaimer disclaims the terminal part of any patent granted on this application that would extend beyond the expiration date of the patent to be granted on the parent application.

#### Conclusion

Applicants believe that the amendments they have made have placed the application in order for allowance.


Favorable consideration of the application is requested.

#### COMMUNICATION BY TELEPHONE

The undersigned's office is located in the United Kingdom, and hence the Examiner may have difficulty contacting him from the USPTO by telephone. If the Examiner wishes to speak with the undersigned by telephone, he can contact the undersigned by e-mail at martinahay@martin-a-hay.com, or leave a message with Linda McDonald at (317) 433 7140 (Eli Lilly and Company).

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Respectfully submitted,

  
Hay, Martin Alexander  
Agent for Applicants  
Registration No. 39,459  
Phone: 011 44 1625 500057  
Email: martinahay@martin-a-hay.com

Customer No. 24330  
[Martin A. Hay & Co.,  
13 Queen Victoria Street  
Macclesfield  
Cheshire  
SK11 6LP  
UNITED KINGDOM]

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